

REMARKS/ARGUMENTS

Claims 1-47 were pending in this application. No claims have been added or canceled. Claims 1, 31, 38, 39, 45, and 46 are amended herein to correct minor inconsistencies between the marked claims and clean claims in the immediately-previous supplemental amendment and/or to correct antecedent references within a claim or among claims. No new material is being added. Hence, claims 1-47 remain pending. Reconsideration of the subject application is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-47, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,903,830 to Joao, *et al.* (hereinafter “Joao”). Applicants believe a *prima facie* case of obviousness has not been properly set forth in the final Office Action with regard to a rejection of claims 1-47. The Examiner is charged with putting forth a *prima facie* showing of obviousness. The basic test is excerpted below:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(See MPEP, Original Eighth Edition, August 2001, §2143) Applicants believe the rejection has flaws with the above test for establishing a *prima facie* case of obviousness.

For example, with regard to the third prong of the test, the cited sections of Joao clearly do not teach or suggest the invention in the claims. More specifically, each of the five independent claims, 1, 13, 28, 31, and 47, includes limitations not taught or suggested by Joao *and which the Office Action concedes are not even mentioned in Joao.* (Specific examples of limitations missing from these and other claims will be presented below.)

Apparently, the Office Action continues to rely on Official Notice to supply the missing limitations, despite Applicant's traversal of such Official Notice and request for a showing of documentary proof. Applicants note that,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts **must be supported, when called for by the applicant, by an affidavit** from the examiner.

(See Id., § 2144.03, emphasis added) Because the Office Action acknowledges that missing limitations are not taught or suggested by Joao, the Applicants are forced to conclude the Office Action is relying on Official Notice. The Applicants again, therefore, respectfully traverse the rejection in each instance and again request either an express showing of documentary proof or an affidavit specifically stating facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2). This amounts to a renewal of Applicant's original request made in response to the first Office Action in this case.

With respect to the first prong of the test, the Office Action fails to cite a motivation or suggestion to modify Joao or combine the teachings of Joao with the apparent Official Notice to achieve the Applicants' claimed invention. Apparently, the Office Action is once again relying on Official Notice to provide such a motivation. The Applicants, therefore, renew the request for either an express showing of documentary proof or an affidavit specifically stating facts within the personal knowledge of the Examiner, as required by 37 CFR § 1.104(d)(2).

Having stated the grounds for traversing the rejections of claims 1-47, we now enumerate specific examples of missing limitations and lack of motivation or

suggestion to modify Joao to achieve Applicants' claimed invention. The above requests for either an express showing of documentary proof or an affidavit specifically stating the facts within the personal knowledge of the Examiner apply to each and every claim discussed in detail below.

With respect to independent claims 1, 13, 28, 31, 45 and 47, Joao does not teach or suggest a target account identifier, receiving a list of target account identifiers of suspected accounts, nor any actions or decisions relating to target account identifiers. This assertion is supported by the Office Action, which admits that Joao does not even mention such things. The Office Action goes on to say the system taught by Joao is "capable" of being modified to include limitations taught by the Applicants. Even if this were true, it would amount to impermissible hindsight reconstruction for which the Office Action has not cited any suggestion or motivation in the prior art that one would attempt to do so. Further, this appears to be a misapplication of the doctrine of inherency, which requires undisclosed elements to be *necessarily* present (*i.e.*, not merely "capable" of being present) in the prior art teaching for the reference to be cited against the claimed element (See MPEP Original Eighth Edition, August 2001, §2112). Thus, claims 1, 13, 28, 31, 45 and 47 are believed to be allowable at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness. Further, all the remaining claims depend, either directly or indirectly from one of claims 1, 13, 28, 31, 45 and 47, and the remaining claims are thus also believed to be allowable, at least on these grounds, since the Office Action has failed to set forth a *prima facie* showing of obviousness. However, additional limitations of the dependent claims not taught or suggested by Joao are addressed in more detail hereinafter.

With respect to claims 2 and 4, the Office Action states that Joao fails to mention an electronic notification sent to a provider or designee of the provider of the target account identifier. This is true. Thus, claims 2 and 4 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claim 3, Joao does not teach target account identifiers upon which the alert sent to the recipient is based. Thus, claim 3 is believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claims 5 and 6, Joao does not teach or suggest that the recipient comprises a compiler of marketing information nor does Joao teach or suggest anything with respect to the content of the marketing information. Thus, claims 5 and 6 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

Claims 8, 25, and 43 are believed to be allowable. The Office Action does not address the additional limitations of claims 8, 25, or 43 vis-à-vis other claims. Thus, the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claims 9-11, 22-24, and 40-42, the Office Action states that Joao does not mention the limitations relating to the time frames within which various operations take place. Since Joao does not even teach comparing target account identifiers and transmitting alerts based on the comparison, the additional limitations of claims 9-11 are even further removed from the teachings of Joao. Thus, claims 9-11, 22-24, and 40-42 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claims 14 and 32, the Office Action states that Joao fails to mention the list comprises an electronic file from a government and/or federal agency. This is true; since Joao fails to teach a list of target account identifiers, Joao certainly fails to teach a source for the list. Thus, claims 14 and 32 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claim 15-18, 29, and 33-36, the Office Action states that Joao fails to mention time frames for receiving the list nor processes for transmitting and/or receiving it. This is true; since Joao fails to teach a list of target account

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identifiers, Joao certainly fails to teach a schedule or process for transmitting and/or receiving it. Thus, claims 15-18, 29, and 33-36 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

With respect to claims 19-21, 37-39, and 46, the Office Action asserts that these claims include limitations addressed with respect to other claims. Applicants disagree and note that claims 19-21, 37-39, and 46 include additional limitations not found in other claims and not addressed by the Office Action. These limitations relate to the delivery of a notification, and a notification which is based on an alert relating to a target account identifier. Since target account identifiers are not taught by Joao, notifications ultimately based on target account identifiers also are not taught by Joao. Thus, claims 19-21, 37-39, and 46 are believed to be allowable, at least on the grounds stated above, since the Office Action has failed to set forth a *prima facie* showing of obviousness.

In light of the foregoing, the Applicants believe all claims are in condition for allowance. Thus, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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